

NOV 29 2006

DOCKET NO. MDFH01-00004
U.S. SERIAL NO. 10/683,571
PATENT**REMARKS**

Claims 21-41 were pending in this application.

Claims 21-41 have been rejected.

Claims 21, 24, and 34 have been amended as shown above.

Claims 21-41 remain pending in this application.

Reconsideration and full allowance of Claims 21-41 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 112

The Office Action rejects Claim 41 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Office Action asserts that the elements recited in Claim 41 are not described in the specification.

Claim 41 has been cancelled. However, Claims 21, 24, and 34 have been amended to contain elements similar to the elements previously recited in Claim 41. As a result, the Applicant shows below how the elements added to Claims 21, 24, and 34 are disclosed in the Applicant's specification.

To satisfy the written description requirement under § 112, a patent application must describe the claimed invention "in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention." A patent applicant can show possession of the claimed invention by "describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention." When making a written description rejection, the Patent Office should review

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“the claims and the entire specification, including the specific embodiments, figures, and sequence listings, to understand how applicant provides support for the various features of the claimed invention.” The initial burden is placed on the Patent Office to present “evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims.” (*MPEP* § 2163).

First, the Office Action fails to present any “evidence or reasoning” to explain “why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims.” The Office Action simply asserts that the elements previously recited in Claim 41 are not described in the specification. This fails to satisfy the burden set forth in *MPEP* § 2163.

Second, take Claim 21 as an example. Claim 21 recites transmitting, from a first mobile device to a central monitoring system, “first position information associated with the first mobile device” and relaying, from the first mobile device directly to the central monitoring system, “second position information associated with a second mobile device.” Claim 21 also recites switching a “mode of operation of the first mobile device” such that the first mobile device “transmits the first position information to at least one of the second mobile device and a third mobile device for relaying to the central monitoring system” and “stops relaying the second position information directly to the central monitoring system.”

The Applicant’s specification clearly recites that a mobile unit may operate in multiple modes. For example, the mobile unit may operate as a “primary” mobile unit or a “secondary” mobile unit. (*Application, Par. [039]*). When operating as a primary unit, the mobile unit communicates with a base station (which forms part of a central monitoring system) and relays

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position information from secondary mobile units to the base station. (*Application, Par. [034]*). When operating as a secondary unit, the mobile unit sends its position information to a primary mobile unit for relay to the base station, and it may or may not relay position information from other secondary mobile units to the primary mobile unit. (*Application, Pars. [034] and [044]*). The base station only communicates directly with the primary mobile units. (*Application, Par. [034]*).

The Applicant's specification clearly notes that a mobile unit can operate in different modes. In a first (primary) mode, the mobile unit communicates with a base station and relays position information from other units directly to the base station. In a second (secondary) mode, the mobile unit cannot communicate directly with a base station and must send its position information to another mobile unit for relaying to the base station. Because the mobile unit cannot communicate directly with the base station in the second mode, the mobile unit cannot relay position information from other mobile units directly to the base station.

It is clear here that a mobile unit that switches from the first mode to the second mode can no longer communicate directly with a base station. If the mobile unit cannot communicate with the base station directly, the mobile unit cannot relay position information from other mobile units directly to the base station. In fact, the Applicant's specification clearly notes that a mobile unit acting in the secondary mode "may or may not" receive and relay position information from other secondary mobile units. (*Application, Par. [044]*). As a result, the Applicant's specification clearly supports Claim 21, which recites switching the "mode of operation" of a first mobile device such that the first mobile device "stops relaying the second position information directly to the central monitoring system." For similar reasons, the Applicant's specification clearly supports Claims 24

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and 34.

Accordingly, the Applicant respectfully requests withdrawal of the § 112 rejection and full allowance of Claims 21-40.

II. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 21-40 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2002/0169539 to Menard et al. ("*Menard*"). This rejection is respectfully traversed.

A prior art reference anticipates a claimed invention under 35 U.S.C. § 102 only if every element of the claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

Claim 21 recites that "first position information" associated with a first mobile device is transmitted from the first mobile device to a central monitoring system and that "second position information" associated with a second mobile device is relayed from the first mobile device directly to the central monitoring system. Claim 21 also recites switching a "mode of operation" of the first mobile device such that (1) the first mobile device "transmits the first position information to at least one of the second mobile device and a third mobile device for relaying to the central monitoring system" and (2) the first mobile device "stops relaying the second position information directly to the

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central monitoring system.”

Menard recites four different devices that “relay” position information. Three of these devices (pager 150, laptop 155, and device 300) are shown in Figure 3 of *Menard*. These devices receive position information, determine if they are authorized to view the position information, and forward the position information towards a monitor center 400. (*Par. [0051]*). The device 300 may also be capable of determining its own location. (*Par. [0082]*). The fourth device described in *Menard* as relaying position information is the monitor center 400, which can relay information between tags 100E-100F and the device 300 as shown in Figure 13. (*Par. [0139]*).

Menard does describe devices that can transmit and relay position information. However, none of these devices in *Menard* operates as recited in Claim 21. For example, the tags 100E-100F of *Menard* may transmit their position information to a device 300 or a tower 415, but the tags 100E-100F do not appear to relay position information from other devices. The pager 150 and the laptop 155 are described as simply relaying information, apparently in a single mode of operation. The monitor center 400 presumably is relied upon as anticipating the “central monitoring system” recited in Claim 21 and cannot therefore be used to anticipate the “first mobile device” recited in Claim 21.

Nothing in *Menard* indicates that any of these devices (1) transmit their own position information and relay another device’s position information to a central monitoring system in one mode and (2) transmit their own position information to another device for relay and stop relaying another device’s position information in another mode.

The Office Action cites paragraphs [0106]-[0107] and Figure 13 of *Menard*. However, these portions of *Menard* lack any mention of switching a “mode of operation” of a mobile device so that

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the mobile device (1) transmits its own position information to another mobile device for relaying to a central monitoring system and (2) stops relaying another device's position information directly to the central monitoring system.

Paragraphs [0106] and [0107] of *Menard* simply describe how the tags 100E-100F can communicate with the device 300 directly using a "short range module" or indirectly (through a tower 415) using a "long range network module." In other words, *Menard* simply recites that a tag may communicate with another device using short-range or long-range transmissions. *Menard* lacks any mention that using one of these modules involves relaying position information from other devices while using another of these modules stops the relaying of position information from other devices.

Figure 13 of *Menard* shows multiple tags 100E-100F in short-range and long-range communication with a device 300 and a tower 415. (*Par. [0084]*). This simply indicates that the tags 100E-100F may communicate with either a local device 300 or the tower 415. Nothing here indicates that any of the tags 100E-100F may switch from one mode (where the tag transmits its own position information to the monitor center and relays position information from another device directly to the monitor center) to a different mode (where the tag transmits its own position information to another device for relaying and stops relaying other devices' position information directly to the monitor center).

For these reasons, *Menard* fails to anticipate Claim 21 (and its dependent claims). For similar reasons, *Menard* fails to anticipate Claims 24 and 34 (and their dependent claims).

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Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejection and full allowance of Claims 21-40.

III. NEW CLAIM

The Applicant has added new Claim 42. The Applicant respectfully submits that no new matter has been added. (*See, e.g., Par. [052]*). At a minimum, the Applicant respectfully submits that Claim 42 is patentable for the reasons discussed above. The Applicant respectfully requests entry and full allowance of Claim 42.

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SUMMARY

The Applicant respectfully asserts that all pending claims in this application are in condition for allowance and respectfully requests full allowance of the claims.

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@munckbutrus.com*.

The Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

Date:

Nov 29, 2006

P.O. Drawer 800889
Dallas, Texas 75380
Phone: (972) 628-3600
Fax: (972) 628-3616
E-mail: *wmunck@munckbutrus.com*



William A. Munck
Registration No. 39,308